

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Short et al.

Examiner: Heyer, Dennis

Application No.: 10/533,063

Group Art Unit: 4121

Filed: May 12, 2006

Docket: P-7714 (102-680 PCT/US/RCE)

For: SUGAR BINDING SURFACE

Dated: April 2, 2010

Confirmation No: 3122

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

REQUEST FOR REFUND

Sir:

Applicants hereby request a refund of \$810.00 charged with the filing of a Request for Continued Examination ("RCE") with respect to the above-identified application.

A RCE was filed on February 1, 2010 in response to an October 30, 2009 Office Action. Attached hereto as Exhibit A is the Office Action Summary Sheet from the October 30, 2009 Office Action indicating that the action was marked Final. Due to the indication of finality of the Office Action, the RCE was filed on February 1, 2010.

Attached here as Exhibit B is a copy of a Notice of Improper Request for Continued Examination (RCE) in which the February 1, 2010 RCE was denied. In particular, the Notice indicates that the RCE was improperly filed in response to a non-final Office Action.

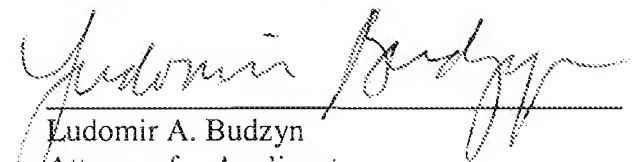
Attached hereto as Exhibit C is a reply to the Notice of Improper Request for Continued Examination in which it is indicated that the Examiner admitted that the indication of finality of

Applicants: Short et al.
Application No.: 10/533,063
Docket No.: 102-680 PCT/US/RCE
Page 2 of 2

the October 30, 2009 Office Action was incorrect. The February 1, 2010 RCE was filed in response to this mistake. Due to the PTO's mistake in marking the October 30, 2009 Office Action as Final, Applicants' hereby request a refund of \$810.00 to Deposit Account No. 08-2461 for the filing of the February 1, 2010 RCE. But for the error of the PTO, this RCE would not have been filed. Considering the error and the denial of entry of the RCE, it is respectfully submitted that a refund is proper.

Favorable action is earnestly solicited. If there are any questions or if additional information is required, please contact Applicants' attorney at the number listed below.

Respectfully submitted,


Ludomir A. Budzyn
Attorney for Applicants
Registration No. 40,540

HOFFMANN & BARON, LLP
6900 Jericho Turnpike
Syosset, NY 11791
(973) 331-1700

EXHIBIT A

Office Action Summary

Application No.

10/533,063

Applicant(s)

SHORT ET AL.

Examiner

DENNIS HEYER

Art Unit

1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 June 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-25 and 33-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-25 and 33-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

EXHIBIT B

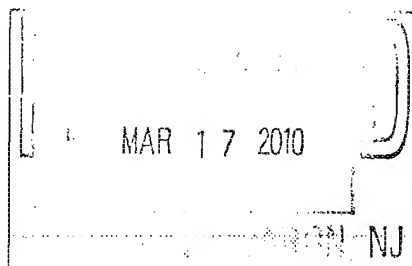


UNITED STATES PATENT AND TRADEMARK OFFICE


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32752 e 03/03/2010
David W. Highet, VP & Chief IP Counsel
Becton, Dickinson and Company
(Hoffman & Baron)
1 Becton Drive, MC 110
Franklin Lakes, NJ 07417-1880



Paper No.

| | | | |
|-----------------------|---|--------------|---------------|
| Application No.: | 10/533,063 | Date Mailed: | 03/03/2010 |
| |  | | |
| First Named Inventor: | Short, Robert, | Examiner: | HEYER, DENNIS |
| Attorney Docket No.: | P-7714 | Art Unit: | 1628 |
| Confirmation No.: | 3122 | Filing Date: | 05/12/2006 |

Please find attached an Office communication concerning this application or proceeding.

Commissioner for Patents

**NOTICE OF IMPROPER REQUEST FOR
CONTINUED EXAMINATION (RCE)**

Application No.
10/533,063

Applicant(s)
SHORT ET AL.

Art Unit
1600

Date Mailed:

The request for continued examination (RCE) under 37 CFR 1.114 filed on 01 February, 2010 is improper for reason(s) indicated below:

1. ☐ Continued examination under 37 CFR 1.114 does not apply to an application for a design patent. Applicant may wish to consider filing a continuing application under 37 CFR 1.53(b) or a CPA under 37 CFR 1.53(d). An RCE cannot be treated as a CPA.
2. ☐ Continued examination under 37 CFR 1.114 does not apply to an application that was filed before June 8, 1995. Applicant may wish to consider filing a continuing application under 37 CFR 1.53(b).
3. ☒ Continued examination under 37 CFR 1.114 does not apply to an application unless prosecution in the application is closed. If the RCE was accompanied by a reply to a non-final Office action, the reply will be entered and considered under 37 CFR 1.111. If the RCE was not accompanied by a reply, the time period set forth in the last Office action continues to run from the mailing date of that action.
4. ☐ The request was not filed before payment of the issue fee, and no petition under 37 CFR 1.313 was granted. If this application has not yet issued as a patent, applicant may wish to consider filing either a petition under 37 CFR 1.313 to withdraw this application from issue, or a continuing application under 37 CFR 1.53(b).
5. ☐ The request was not filed before abandonment of the application. The application was abandoned, or proceedings terminated on _____. Applicant may wish to consider filing a petition under 37 CFR 1.137 to revive this abandoned application.
6. ☐ The request was not accompanied by the fee set forth in 37 CFR 1.17(e) as required by 37 CFR 1.114. Since the application is not under appeal, the time period set forth in the final Office action or notice of allowance continues to run from the mailing date of that action or notice.
7. ☐ The request was not accompanied by a submission as required by 37 CFR 1.114. Since the application is not under appeal, the time period set forth in the final Office action or notice of allowance continues to run from the mailing date of that action or notice.

Note: A continued prosecution application (CPA) under 37 CFR 1.53(d) cannot be filed in a utility or plant application. A CPA filed in a utility or plant application that has a filing date **on or after June 8, 1995** will be treated as an RCE under 37 CFR 1.114. The request for a CPA in the instant application, however, has been treated as an improper RCE for the reason(s) indicated above.

A copy of this Notice MUST be returned with the reply.

Direct any questions concerning this notice to

/GOIGA N. DUCKETT/, Technology Center 1600

Telephone Number: (571)272-0522

EXHIBIT C

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Short et al.

Examiner: Heyer, Dennis

Application No.: 10/533,063

Group Art Unit: 4121

Filed: May 12, 2006

Docket: P-7714 (102-680 PCT/US/RCE)

For: SUGAR BINDING SURFACE

Dated: April 2, 2010

Confirmation No: 3122

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P.O. Box 1450
Alexandria, VA 22313-1450

**REPLY TO NOTICE OF IMPROPER
REQUEST FOR CONTINUED EXAMINATION**

Sir:

A Notice of Improper Request for Continued Examination (RCE) was mailed on March 3, 2010 indicating that a Request for Continued Examination filed on February 1, 2010 with respect to the above-identified application was improper. In particular, it was indicated that the RCE filing was in a reply to a non-final Office Action.

For the record, an Office Action was issued on October 30, 2009 which, on the Office Action Summary Sheet, was indicated to be Final. In response to the October 30, 2009 Office Action, an Amendment and a Request for Continued Examination was filed on February 1, 2010.

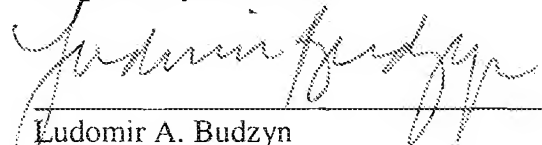
After receipt of the March 3, 2010 Notice of Improper RCE, this office was informed by Examiner Dennis Heyer, the Examiner who issued the October 30, 2009 Office Action, that the Office Action was inadvertently marked as being Final. In fact, the Office Action was non-final.

Applicants: Short et al.
Application No.: 10/533,063
Docket No.: 102-680 PCT/US/RCE
Page 2 of 2

In view of this mistake, Applicants hereby accept the denial of entry of the Request for Continued Examination. If in fact the October 30, 2009 Office Action is found to have been correctly marked Final, Applicants hereby request automatic reinstatement of the Request for Continued Examination.

If there are any questions or concerns, please contact Applicants' attorney at the number listed below.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read 'Ludomir A. Budzyn', written over a horizontal line.

Ludomir A. Budzyn
Attorney for Applicants
Registration No. 40,540

HOFFMANN & BARON, LLP
6900 Jericho Turnpike
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